



DEPARTMENT OF COMMERCE

[3510-16]

United States Patent and Trademark Office

[Docket No.: PTO-C-2012-0037]

Request to Make Special Program for the Law School Clinic Certification Patent Pilot Program

AGENCY: United States Patent and Trademark Office, Commerce

ACTIONS: Notice.

SUMMARY: The United States Patent and Trademark Office (USPTO) is implementing a pilot program in which a law school clinic participating in the USPTO Law School Clinic Certification Pilot Program may file an application for a pro bono client of the law school clinic and that applicant's application may be advanced out of turn (accorded special status) for examination. Each school participating in the patent pilot program would be allotted up to two applications to be examined out of turn per semester. The total number of applications to be examined out of turn by law school clinics participating in the USPTO Law School Clinic Certification Pilot Program is limited to sixty-four per year.

DATES: Effective Date: [INSERT DATE OF PUBLICATION IN FEDERAL REGISTER].

Duration: The Request to Make Special for the Law School Clinic Certification Pilot Program will run for the duration of the Law School Certification Clinic Pilot Program or until otherwise announced.

FOR FURTHER INFORMATION CONTACT: William R. Covey, Deputy General Counsel for Enrollment and Discipline and Director of Enrollment and Discipline, by telephone at 571-272-4097; by facsimile transmission to 571-273-0074, marked to the attention of William R. Covey; by mail addressed to: Mail Stop OED, USPTO, P.O. Box 1450, Alexandria, VA 22313-1450.

SUPPLEMENTARY INFORMATION: New patent applications are normally taken up for examination in the order of their United States filing date. See section 708 of the Manual of Patent Examining Procedure (8th ed. 2001) (Rev. 8, July 2010) (MPEP). The USPTO has a procedure under which an application will be advanced out of turn (accorded special status) for examination if the applicant files a petition to make special with the appropriate showing. See 37 CFR 1.102 and MPEP 708.02. The USPTO revised its accelerated examination program in June of 2006, and required that all petitions to make special, except those based on applicant's health or age or the Patent Prosecution Highway (PPH) pilot program, comply with the requirements of the revised accelerated examination program. See Changes to Practice for Petitions in Patent

Applications To Make Special and for Accelerated Examination, 71 FR 36323 (June 26, 2006), 1308 Off. Gaz. Pat. Office 106 (July 18, 2006) (notice); Changes to Implement the Prioritized Examination Track (Track I) of the Enhanced Examination Timing Control Procedures Under the Leahy-Smith America Invents Act, 76 FR 59050 (September 23, 2011); see also MPEP 708.02(a) and (b). Applications that are accorded special status are generally placed on the examiner's special docket throughout its entire course of prosecution before the examiner, and have special status in any appeal to the Patent Trial and Appeal Board (PTAB) and also in the patent publication process. See MPEP 708.01 and 1309.

Currently, a participating law school clinic files the client's application and the application is placed on the regular docket of the examiner. Due to the the time for initial substantive examination, students are currently unable to receive the benefit of any action by the Office prior to completion of their clinic program. Allowing a limited number of applications per semester per school to be advanced out of turn will provide the law students with practical experience as they will be more likely to receive substantive examination of applications within the school year that the application is filed. When filing the Request to Make Special, a school must certify that it provides all patent clinic clients with patentability searches and opinions prior to qualifying to receive any application advanced out of turn. Further the school must file a Request to Make Special in order for a patent application to be granted special status.

The USPTO is implementing a pilot program to permit up to two applications per academic term filed by a law school clinic program participating in the USPTO Law School Clinic Certification Pilot Program to be advanced out of turn without meeting all of the current requirements of the accelerated examination program or prioritized examination set forth in MPEP 708.02(a) and (b). Additional applications may be advanced out of turn based upon a request by the participating law school clinic program.

Applications that are accorded special status under the Request to Make Special for the Law School Clinic Certification Pilot Program will be placed on an examiner's special docket prior to the first Office action, and will have special status in any appeal to the PTAB and also in the patent publication process. Applications accorded special status under the Request to Make Special for the Law School Clinic Certification Pilot Program, however, will be placed on the examiner's amended docket, rather than the examiner's special docket, after the first Office action (which may be an Office action containing only a restriction requirement).

An eligible law school may participate in the Request to Make Special for the Law School Clinic Certification Pilot Program by filing a request to make special that meets all of the requirements set forth in this notice. No fee is required. The \$130.00 fee for a petition under 37 CFR 1.102 (other than those enumerated in 37 CFR 1.102(c)) is hereby sua sponte waived for requests to make special based upon the procedure specified in this notice. In addition, continuing applications will not automatically be accorded special

status based on papers filed with a request in a parent application. Each continuing application must on its own meet all requirements for special status.

I. Requirements: A request to make special under the Request to Make Special for the Law School Clinic Certification Pilot may be granted in an application if the eligibility requirements set forth in section II or III and the following conditions are satisfied:

(1) The application must be a non-reissue, non-provisional utility application filed under 35 U.S.C. 111(a), or an international application that has entered the national stage in compliance with 35 U.S.C. 371. Reexamination proceedings are excluded from this pilot program.

(2) The application must be submitted by a law school participating in the Law School Clinic Certification Pilot Program on behalf of a pro bono client.

(3) The application must contain three or fewer independent claims and twenty or fewer total claims. The application must not contain any multiple dependent claims. For an application that contains more than three independent claims or twenty total claims, or multiple dependent claims, applicants must file a preliminary amendment in compliance with 37 CFR 1.121 to cancel the excess claims and/or the multiple dependent claims at the time the request to make special is filed.

(4) The claims must be directed to a single invention. The request must include a statement that, if the USPTO determines that the claims are directed to multiple

inventions (e.g., in a restriction requirement), applicant will agree to make an election without traverse in a telephonic interview. See section III of this notice for more information.

(5) The request to make special must be filed electronically using the USPTO electronic filing system, EFS-Web, and selecting the document description of "Certification and Request to Make Special Under the Law School Pilot Program" on the EFS-Web screen. Applicant should use form PTO/SB/419, which will be available as a Portable Document Format (PDF) fillable form in EFS-Web and on the USPTO Web site at <http://www.uspto.gov/web/forms/index.jsp>. Information regarding EFS-Web is available on the USPTO Web site at <http://www.uspto.gov/ebc/index.html>.

(6) The request to make special must be filed at least one day prior to the date that a first Office action (which may be an Office action containing only a restriction requirement) appears in the Patent Application Information Retrieval (PAIR) system. Applicant may check the status of the application using PAIR.

(7) The request to make special must be accompanied by a request for early publication in compliance with 37 CFR 1.219 and the publication fee set forth in 37 CFR 1.18(d).

(8) The request to make special must be filed on behalf of a small entity.

II. Decision on the Request to Make Special for the Law School Clinic Certification Pilot

Program: If applicant files a request to make special through the Law School Clinic Certification Pilot Program, the USPTO will decide on the request once the application is in condition for examination. If the request is granted, the application will be accorded special status under the Request to Make Special for the Law School Clinic Certification Pilot Program. The application will be placed on the examiner's special docket prior to the first Office action, and will have special status in any appeal to the PTAB and also in the patent publication process. The application, however, will be placed on the examiner's amended docket, rather than the examiner's special docket, after the first Office action (which may be an Office action containing only a restriction requirement).

If applicant files a request to make special under the Request to Make Special for the Law School Clinic Certification Pilot Program that does not comply with the requirements set forth in this notice, the USPTO will notify the applicant of the deficiency by issuing a notice, and applicant will be given only one opportunity to correct the deficiency. If applicant still wishes to participate in the Request to Make Special for the Law School Clinic Certification Pilot Program, applicant must file a proper request and make appropriate corrections within one month or thirty days, whichever is longer. The time period for reply is not extendable under 37 CFR 1.136(a). If applicant fails to correct the deficiency indicated in the notice within the time period set forth therein, the application will not be eligible for the Request to Make Special for the Law School Clinic Certification Pilot Program and the application will be taken up for examination in accordance with standard examination procedures.

III. Requirement for Restriction: If the claims in the application are directed to multiple inventions, the examiner may make a requirement for restriction in accordance with current restriction practice prior to conducting a search. The examiner will contact the applicant and follow the procedure for the telephone restriction practice set forth in MPEP 812.01. Applicant must make an election without traverse in a telephonic interview. See item 4 of section I of this notice. If the examiner cannot reach the applicant after a reasonable effort or applicant refuses to make an election in compliance with item 4 of section I of this notice, the examiner will treat the first claimed invention as constructively elected without traverse for examination.

Date: September 25, 2012

David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

[FR Doc. 2012-24113 Filed 09/28/2012 at 8:45 am; Publication Date: 10/01/2012]